

REMARKS

I. Status of the Claims

Claims 36-43, 45-47, 49, 51, 52 and 54-68 were pending. Applicants acknowledge with appreciation that claims 49, 51, 52 and 54-60 were allowed and claims 37-41 were deemed allowable if rewritten in independent form.

Claim 36 has been amended herein to specify that the joint is in a living subject, as described throughout the specification as filed. Thus, claims 36-43, 45-47, 49, 51, 52, and 54-68 are pending as shown above.

In view of the foregoing amendment and following remarks, Applicants respectfully requested reconsideration of the application.

II. Rejections Under 35 U.S.C. § 102(a)

A. Claims 36, 42, 43 and 61-64 over Herberhold

Claims 36, 42, 43 and 61-64 were rejected as allegedly anticipated by Herberhold et al. (1998) *MRM* 39:843-850 (hereinafter "Herberhold"). Office Action, paragraph 1. The Office Action states that Herberhold discloses "a method of assessing the change of cartilage in a human knee over time using MRI imaging." *Id.*

Because Herberhold does not disclose or suggest all the elements set forth in claims 36, 42, 43 and 61-64, Applicants respectfully traverse this rejection.

Pending claims 36, 42, 43 and 61-64 are directed to methods of assessing the change over time of cartilage in the joint of a live human by assessing cartilage thickness at two different time points. In these methods, an external force is not applied to the joint -- the live subject is either stationary during imaging or moving under their own power. In contrast, Herberhold relates entirely to methods of determining deformation of cartilage from cadaver joints in response to external mechanical loading. Accordingly, Herberhold fails to teach or suggest each and every element of pending claims 36, 42, 43 and 61-64 and Applicants respectfully request withdrawal of this rejection.

III. Rejections Under 35 U.S.C. § 102(e)

A. Claims 36, 42, 43, 45-47 and 61-68 over Pelletier

Claims 36, 42, 43, 45-47 and 61-68 were rejected as allegedly anticipated by U.S. Patent No. 6,560,476 (hereinafter "Pelletier"). Office Action, paragraph 2. Pelletier was cited for allegedly disclosing "a method of assessing the change in thickness, width, area and volume of cartilage in a human knee..." *Id.*

Applicants refer the Office to the paragraph [0002] of the pending specification in which the priority information is set forth. As indicated, the effective filing date of the pending application is December 16, 1998. Accordingly, Pelletier is not a proper reference against any of the pending claims inasmuch Pelletier's earliest priority date is November 1, 1999. Therefore, the teachings of Pelletier cannot be used against the pending claims and Applicants respectfully request withdrawal of this rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the pending claims are in condition for allowance and request early notification to that effect.

Should the Examiner have any further questions, Applicants request that the undersigned be contacted at (650) 493-3400.

Respectfully submitted,

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